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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/560,222	04/28/2000	Paul Haerberli	11087-014001	3668
31688	7590	12/22/2004	EXAMINER	
TRAN & ASSOCIATES 6768 MEADOW VISTA CT. SAN JOSE, CA 95135			FADOK, MARK A	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/560,222

Applicant(s)

HAEBERLI, PAUL

Examiner

Mark Fadok

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 112-136 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 112-136 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None, of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Response to Amendment

The examiner is in receipt of applicant's response to office action mailed 8/4/2004, which was received 9/24/2004. Acknowledgement is made to the amendment to claim 112, leaving claims 112-136 as pending in the application. The amendment and arguments have been carefully considered the amendment was sufficient to obviate the examiner's objection to claim 1, but were not found to be persuasive in regards to the rejection on the merits, therefore, the previous rejection modified as required by applicant's amendment follows

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 112-135 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle and further in view of Official Notice.

In regards to claim 112, Garfinkle discloses receiving a first image from a user (FIG 3);

receiving a request for a demonstration of an image-based product by the user (FIG 5B);

Garfinkle teaches processing digital photos along with delivering and storing digital image products on a server for a customer to upload and download images to a client computer for modification of attributes of the digital image from a client computer (col 7, lines 4-42) and plurality of products (thumbnails, gifts, col 7, lines 53-60), but does not specifically mention that the attributes are automatically selected and presented to the user. It would have been obvious to a person having ordinary skill in the art to include in Garfinkle, automatically demonstrating a product with modifications available, since it has been held that broadly providing a mechanical or automatic means to replace manual activity, which has accomplished the same result, involves only routine skill in the art. *In re Venner*, 120 USPQ 192. Garfinkle would have been motivated to incorporate the demonstration of a product, because this is a notoriously well known method for showing a product for sale that is modified from its original presentation; for example, showing the tee shirt or mug of Garfinkle with the image shown on it provides for an excellent way for people to visualize the product and thus increase the likelihood of a sale.

Applicant may argue that the manipulation of the product attributes occurs not on the server, but at the client computer. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to (describe modification), since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

In regards to claim 113, Garfinkle teaches displaying the first preview image of the image-based product (col 7, lines 5-40).

In regards to claim 114, Garfinkle teaches wherein displaying the first preview image of the image-based product includes:

downloading the first preview image to a client computer; and displaying the first preview image in the client computer (col 7, lines 5-40).

In regards to claim 115, Garfinkle teaches uploading the first image from a client computer to a server using a computer network (FIG 1).

In regards to claim 116, Garfinkle teaches receiving a selection of the first image from a plurality of images (FIG 5B)

In regards to claims 117-135, the features claimed are old and well known in digital image processing software and are notoriously well known in photo processing software such as Adobe Photoshop (see Garfinkle col 7). It would have been obvious to a person having ordinary skill in the art to include in Garfinkle, the myriad of functional features of the instant claims along with others available in the art at the time of the invention, because this would provide the user increased functionality and cause more users to use the site to attain these functionalities, thus increasing sales.

Response to Arguments

Applicant argues that the method of Garfinkle requires manual operation, whereas the instant application completes these operations manually. The examiner agrees and notes that this difference was treated in the last office action as is noted by the applicant on page 5 of the remarks. The examiner maintains that the instant application merely automates a common function of cropping, bordering, changing a photograph into a oil like painting or a water color picture, ect, see (Yokomizo (col 3, line 65, for an example or these and other functions or the demonstration of options and styles as is shown in Fredlund (col 6, lines 7-15).

In response to applicant's argument that there is no suggestion to combine the references and no reasonable expectation of success, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Garfinkle would have been motivated to incorporate the demonstration of a product, because this is a notoriously well known method for showing a product for sale that is modified from its original presentation; for example, showing the tee shirt or mug of Garfinkle with the image shown on it provides for an

excellent way for people to visualize the product and thus increase the likelihood of a sale.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **(703) 605-4252**. The examiner can normally be reached Monday thru Thursday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **(703) 308-1344**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 308-1113**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

(703) 872-9306 [Official communications; including
After Final communications labeled
"Box AF"]

(703) 746-7206 [Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.



Mark Fadok

Patent Examiner